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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,536	02/10/2004	James J. Rudnick	760-84 CON 4	6703
23869 7590 11/12/2008 HOFFMANN & BARON, LLP 6900 JERICHO TURNPIKE SYOSSET, NY 11791				
EXAMINER				
SCHILLINGER, ANN M				
ART UNIT		PAPER NUMBER		
3774				
MAIL DATE		DELIVERY MODE		
11/12/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/775,536

Applicant(s)

RUDNICK ET AL.

Examiner

ANN SCHILLINGER

Art Unit

3774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Terminal Disclaimer

The terminal disclaimers filed on 8/7/2008 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration dates of 11/19/1996 and 11/20/2001 has been reviewed and is accepted. The terminal disclaimers have been recorded.

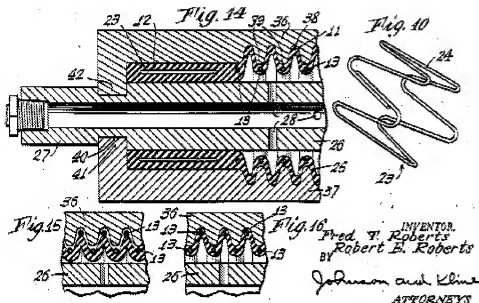
Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 26, 30, 31, 33, and 34 are rejected under 35 U.S.C. 102(b) as anticipated by Roberts, et al. (US Pat. No. 2,780,274). Roberts, et al discloses a tubular device having wire defining a plurality of nested wire waves and a non-porous cover extending along the length of the tubular device. While the device is not intended for intraluminal applications, the resulting structure would provide the function of not allowing free tissue ingrowth through the cover and through the wire. See column 3, lines 30+.



Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Das (US Pat. No. 5,554,181) in view of Song (US Pat. No. 5,330,500). Das discloses the following of the claimed invention: an elongate tubular stent (1) with nested wire waves (col. 6, lines 45-54) with varying amplitudes (please see Figure 1). The stent may be constructed into various patterns from a single, continuous helically wound wire (col. 2, lines 54-65; col. 9, lines 43-58). However, Das does not disclose a cover on the stent. Song teaches a stent with a mesh cover that may be coated with silicone rubber in col. 3, line 40-62 for the purpose of preventing cell penetration into the prosthesis. Therefore, it would have been obvious to one of ordinary skill in

the art at the time the invention was made to place a cover on the stent in order to prevent cell penetration.

Please note that the examiner is interpreting the terms “film” and “membrane” by their dictionary definitions. “Film” is defined as “a thin sheet of any material” (film. Dictionary.com. *Dictionary.com Unabridged (v 1.1)*. Random House, Inc. <http://dictionary.reference.com/browse/film> (accessed: May 07, 2008)). “Membrane” is defined as “a thin pliable sheet of material” (membrane. Dictionary.com. *WordNet® 3.0*. Princeton University. <http://dictionary.reference.com/browse/membrane> (accessed: May 07, 2008)). The stent covering described in the Song reference meets the limitations of these terms, as set forth by their respective definitions.

Response to Arguments.

Applicant's arguments filed 8/7/2008 have been fully considered but they are not persuasive. The Applicant contends that the Roberts et al. reference is not in an analogous art area, and therefore does not qualify as prior art to the claimed invention. As stated in the previous office action, it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. The preamble of claim 26 provides no structural limitations for the claimed device, only the device's intended use. Therefore, in the instant case, the preamble is still denied the effect of a limitation. In addition, the Roberts et al. reference meets the structural limitations of a stent, as shown in Figure 1. Further regarding the claim language describing how the device is intended to be used (i.e., as an intraluminal device and to inhibit tissue growth), it has been held that a

recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the structural limitations. See MPEP 2114.

Regarding the arguments addressing the Das and Song references, the Applicant contends that the Das reference does not disclose a stent having nested wire waves. The Applicant has described, but not explicitly defined the term "nesting" in the specification. Therefore, the term is given its broadest, reasonable interpretation, where the claim language is read in light of the specification, but limitations from the specification may not be read into the claim. The examiner is interpreting the term "nested" from its dictionary definition: "an assemblage of things lying or set close together, as a series of boxes or trays that fit within each other" (nest. Dictionary.com. *Dictionary.com Unabridged (v 1.1)*. Random House, Inc. <http://dictionary.reference.com/browse/nest> (accessed: October 29, 2008)). The Das reference shows nested wire waves in Figure 1 and in col. 6, lines 45-54.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANN SCHILLINGER whose telephone number is (571)272-6652. The examiner can normally be reached on Mon. thru Fri. 9 a.m. to 4 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Isabella can be reached on (571) 272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. S./
Examiner, Art Unit 3774/

William H. Matthews/
Primary Examiner, Art Unit 3774